RECEIVED
CENTRAL FAX CENTER
AUG 2 3 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alberth, Jr. et al.
For:	Method and Apparatus for Storing a Message for Playback during a User-Initiated Emergency Telephone Call from a Wireless Device
Serial No.:	09/610,768
Filed:	July 6, 2000
Examiner:	Tran, T.
Art Unit:	2684

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is being filed in conjunction with a NOTICE OF APPEAL filed herewith.

Any fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying NOTICE OF APPEAL AND TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)):

I REAL PARTY IN INTEREST

II RELATED APPEALS AND INTERFERENCES

III STATUS OF CLAIMS

08/25/2005 RFEKADU1 00000036 502117 09610768
02 FC:1402 500.00 DA

IV STATUS OF AMENDMENTS

V SUMMARY OF CLAIMED SUBJECT MATTER

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

VII ARGUMENT

A. Rejections under 35 U.S.C. 103

VIII CLAIMS APPENDIX

XI EVIDENCE APPENDIX

A. Computer generated English translation of Tanaka, (JP Patent Publication No. 08-251313)

X RELATED PROCEEDINGS APPENDIX (not applicable)

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS

A. Status of all claims in the proceeding

1. Claims rejected: 1, 2, 4, 11-13, 26, 28 and 29
2. Claims allowed: 5-10, 14-24, 27 and 30
3. Claims withdrawn from consideration but not canceled: none
4. Claims objected to: none
5. Claims canceled: 3 and 25

B. Identification of claims being appealed

The claims on appeal are: 1, 2, 4, 11-13, 26, 28 and 29

IV. STATUS OF ANY AMENDMENTS AFTER FINAL

No amendments have been filed after final.

V. SUMMARY OF INVENTION

The invention pertains to a wireless device, and a method for sending a message stored in the memory of the wireless device. The claimed device and method has particular relevance to emergency messages being transmitted during emergency situations, such as user initiated emergency calls (page 1, lines 2-5).

In at least one instance, when a call associated with sending a message is initiated by the user, a timer is initiated, which delays sending the message until a predetermined time has elapsed as detected by the timer (page 8, lines 12-19). This allows for a period of time, which exists before the message is sent, in which the anticipated delivery of the message can be avoided (page 2, lines 23-27). In the same or alternative instances, once the call associated with transmitting a message has been initiated, the actual sending of the message can be avoided or interrupted when an audio signal, such as the user's voice, is detected from an external source, such as via the microphone of the wireless device (page 2, lines 28-32; page 8, lines 19-22). Still further in the same or other instances, the detection of the activation of a key can also be used to interrupt or terminate the sending of the stored message (page 9, lines 3-6).

Where the message is a data message, which includes emergency information, the message can additionally include a digital signature (page 11, line 35 to page 12, line 1).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 2, 13, 26 and 29 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Nichols (US Patent No. 5,109,525).

2. Whether claim 28 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Nichols (US Patent No. 5,109,525), and further in view of Tanaka (JP Patent Publication No. 08-251313).

3. Whether claims 4 and 12 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Tanaka (JP Patent Publication No. 08-251313).

4. Whether claim 11 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Ebata et al. (US Patent No. 6,487,542).

VII. ARGUMENTS

A. Rejections under 35 U.S.C. 103

The Examiner has rejected claims 1, 2, 4, 11-13, 26, 28 and 29 under 35 U.S.C 103(a) as being unpatentable over Alpert, '666, in view of one or more of Nichols, '525, Tanaka, '313, and Ebata et al., '542. However, in each instance, the rejection has been misapplied. The specific reasoning outlining the misapplication of the rejections are noted below.

The Federal Circuit has repeatedly emphasized that, with respect to obviousness, the standard for patentability is the statutory standard. The inquiry is whether the claimed subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. In this regard, see for example, Monarch Knitting Machinery Corp. v. Saulzer Maurat GMBH, 139 F.3d 877, 881, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

For purposes of formulating an obviousness type rejection, the Patent and Trademark Office (PTO) has the initial burden of presenting a prima facie case. In re Mayne, 104 F.3d 1339, 1341, 41 USPQ2d 1451 (Fed. Cir. 1997). In order to establish a prima facie case of obviousness, it must be shown that the prior art reference, or references when combined, teach or suggest all of the claim limitations. Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996), In re Royka, 490 F.2d 981, 180 USPQ 580, 583 (CCPA 1974). Furthermore, the showing of a suggestion, teaching, or motivation to combine

prior teachings "must be clear and particular." In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). These requirements are consistent with the Patent and Trademark Office's own examination guidelines governing the formation of obvious type rejections, see MPEP §2142.

1. Whether claims 1, 2, 13, 26 and 29 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Nichols (US Patent No. 5,109,525).

In attempting to reject claims, the Examiner correctly acknowledges that minimally Alpert, '666, fails to teach or suggest initiating a timer when the call is established, and sending a stored message from a wireless device when a predetermined time has elapsed on the timer. However, contrary to the Examiner's assertions the teachings of Nichols, '525, fails to account for the above noted deficiencies, either alone or when taken together with Alpert, '666, in so far as Nichols, '525, similarly minimally fails to make known or obvious sending the stored message when a predetermined time has elapsed on a timer wherein the timer is initiated when the call is established, as provided by the present claims. Alternatively, Nichols, '525, provides that "the controller can include a timer 35 for adding a random time delay at blocks 54, 60, and 74 prior to deciding that the channel is not busy" (col. 3, lines 29-31) (emphasis added). However, the Examiner, in formulating the rejection, alternatively describes the reference as including a timer, which is applied to delay the operational execution such as checking channel availability before transmission of stored message. A timer used to delay the checking of channel availability is not the same as a timer, which is initiated when a call is established. A call cannot be established until a channel is available, such that a timer which delays checking channel availability, would occur before a call is established, and therefore can not be equated to being initiated when the call is established. Consequently, Nichols, '525, similarly fails to make up for the deficiencies of Alpert, '666, in attempting to make known or obvious claims 1-2, 13, 26 and 29, and therefore maintenance of the rejection is improper. The same reasoning is equally applicable to the Examiner's rejection of claim 28, in so far as claim 28 similarly includes a corresponding feature, which has been incorrectly attributed by the Examiner to the above noted

references. As a result, the Examiner's rejection of claims 1-2, 13, 26 and 29 (and claim 28 as noted below) can not be reasonably maintained.

2. Whether claim 28 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Nichols (US Patent No. 5,109,525), and further in view of Tanaka (JP Patent Publication No. 08-251313).

Claim 28 is dependent upon claim 26, which as noted above is presently allowable over the references, which are being presently relied upon by the Examiner, and therefore claim 28 is similarly allowable for the same reasons noted above. Furthermore claim 28 provides the further feature of terminating the transmission of a stored message when a voice signal is picked-up by a microphone of the wireless device. While the Examiner acknowledges that neither Alpert, '666, nor Nichols, '525, teach or suggest this feature, the Examiner attempts to assert, that Tanaka, '313, makes known the identified feature. However, the Examiner has misconstrued the teachings in attempting to apply the references to the claims of the present application. More specifically, Tanaka, JP 08251313, is directed to the sharing of a transmission line between a voice signal (i.e. packetized voice signal) and a data signal (i.e. Fax signal). However, contrary to the noted claims of the present application, Tanaka, '313, does not terminate the transmission as provided in claim 28, but alternatively suspends the transmission temporarily, such that the transmission of data signal is expected to proceed when the voice signal is no longer present. Such is made clear through a review of a machine generated translation of the reference, which is provided through the Japanese Patent Office web site, a copy of the same is attached to the present brief and is noted in the evidence appendix at the end of the brief. "Terminate" is inconsistent with the teachings of the reference, in so far as the reference expressly provides for the eventual completion of the transmission. Consequently, contrary to the Examiner's assertions, the combination of references as relied upon by the Examiner, either alone or together, fails to teach or suggest each and every feature of the claims, and therefore the Examiner has failed to establish a proper prima facie case for obviousness.

3. Whether claims 4 and 12 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666), in view of Tanaka (JP Patent Publication No. 08-251313).

For the same reasons noted above with respect to claim 28, the teachings of Tanaka, '313, are inconsistent with terminate, as provided in claim 12. Furthermore the suspension as taught by Tanaka, '313, is similarly inconsistent with "not sending", as provided by claim 4, if the audio signals have been detected. By resuming the transmission as taught by Tanaka, '313, after audio signals have been detected, Tanaka, '313, effectively teaches away from claim 4, as Tanaka teaches sending the stored message even after audio signals have been detected. Consequently, contrary to the Examiner's assertions, the teachings and suggestions from the combination of references being relied upon by the Examiner, when taken either alone or together, fail to teach or suggest each and every feature of the claims. Hence, the Examiner has failed to properly reject the claims.

4. Whether claim 11 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666) , in view of Ebata et al. (US Patent No. 6,487,542).

Relative to claim 11, the Examiner has attempted to suggest that Ebata et al., US Patent No. 6,487,542, in combination with Alpert, '666, makes known the inclusion of a digital signature with the data message including emergency information. However, such an assertion is simply without merit. The Examiner has failed to provide any teaching or suggestion in the references for such a combination, and/or any motivation as to why the same would be obvious in the present context and/or the context of the base reference, namely Alpert, '666, where the additional reference, Ebata et al., '542, generally relates to a digital signature which is obtained by encrypting the data or message with the secret key of the user at the sending terminal for purposes of security (i.e. avoid wire tapping).

In the present context, the digital signature is associated with the data message including emergency information, which in at least some embodiments of the present invention insures the legitimacy and correspondingly in at least some instances potentially enables an event to have a

legal effect, which might be important in circumstances involving an at least partially automated response. This can be important, where the triggering of the at least partially automated response might imply an emergency condition in which the user can not otherwise respond, which might make the legally established effect of a digital signature associated with the data message relevant. Alternatively, Ebata et al., is associated with security associated with communications associated with money management. While with respect to money management, one probably does not want third parties to have access to the information contained within the communication, in the case of an emergency, it is likely a person would welcome assistance from any source. The Examiner has made no attempt to reconcile these differences. Because the Examiner has failed to properly establish a proper motivation to incorporate a digital signature, as provided by Ebata et al., '542, in a context consistent with the Alpert, '666, one skilled in the art can not be said to be motivated to combine the same, in a manner which would make known or obvious the corresponding claims of the present invention. Consequently the corresponding rejection should be reversed.

In view of the above analysis, the applicants would assert, that the Examiner has failed to establish that any of the cited references either separately or in combination make known or obvious any of the presently pending claims. The applicants would respectfully request that the Examiner's decision to finally reject the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

BY: Lawrence Chapa

Lawrence J. Chapa
Reg. No. 39,135
Phone No.: (847) 523-0340

Motorola, Inc.
Mobile Devices
Intellectual Property Department
600 North US Highway 45, AS437
Libertyville, IL 60048

VIII. CLAIMS APPENDIX

The following is the text of the claims involved in this appeal:

1. A method for sending a message stored in memory associated with the wireless device, comprising:

a) initiating a call from the wireless device;

b) initiating a timer when the call is established; and

c) sending the stored message from the wireless device when a predetermined time has elapsed on the timer.

2. The method of claim 1, further comprising:

d) sending position data from the wireless device when the call is established.

3. (Canceled)

4. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals; and

c) sending the stored message from the wireless device after a call is established if audio signals have not been detected being picked-up by the microphone of the wireless device; and

d) not sending the stored message from the wireless device if audio signals have been detected being picked-up by the microphone of the wireless device.

5. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals;

c) sending the stored message from the wireless device after a call is established; and

d) adding audio signals picked-up by the microphone of the wireless device into the stored message and sending the resultant combined signal.

6. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device to a base;

b) sending the stored message from the wireless device to the base after a call is established;

c) detecting a playback command received from the base, in response to the operator of the base depressing a keypad key; and

d) resending the stored message from the wireless device responsive to detecting the command received from the base.

7. The method of claim 6, wherein step a) comprises

detecting actuation of a speed-dial key and initiating the call from the wireless device in response to detecting actuation of the speed-dial key.

8. The method of claim 5, and further including the step of storing an audio message picked-up from a microphone of the wireless device in a memory associated with the wireless device after initiating the call.

9. The method of claim 5, further including the step of storing a data message in a memory associated with the wireless device.

10. The method of claim 9, wherein the data message is part of a radio repertoire.

11. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) storing a data message including emergency information in the memory, the data message additionally including a digital signature;

b) initiating an emergency call from the wireless device to a base; and

c) sending the stored message from the wireless device to the base after the emergency call is established.

12. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals;

c) sending the stored message from the wireless device after a call is established; and

d) terminating sending the stored message when an audio signal is picked-up by a microphone of the wireless device.

13. The method of claim 1, further including terminating sending the stored message when a key of the wireless device is activated.

14. A method for sending a message from a wireless device, including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) storing audio detected by the microphone upon initiating the call in a memory associated with the wireless device; and

c) upon establishing the call, sending the audio that was stored upon initiating the call.

15. The method of claim 14, further comprising:

d) sending position data from the wireless device once the call is established.

16. The method of claim 14, wherein step c) comprises the step of:

d) sending the stored message if voice signals are not detected via the microphone of the wireless device within a predetermined time after the call is established.

17. The method of claim 14, wherein step c) comprises the step of:

d) terminating sending the stored message if audio signals are detected via the microphone of the wireless device.

18. The method of claim 14, wherein step c) comprises the step of:

d) terminating sending the stored message when a key of the wireless device is activated.

19. The method of claim 14, further comprising:

d) resending the stored message from the wireless device when a command is detected on a downlink channel.

20. The method of claim 14, wherein step a) comprises the step of:

d) initiating a call from the wireless device by depressing a speed-dial key.

21. The method of claim 14, wherein step b) comprises the step of:

d) storing the message picked-up from a microphone of the wireless device in a memory associated with the wireless device.

22. The method of claim 14, wherein step b) comprises the step of:

d) if necessary, reallocating the memory to store the message.

23. A wireless device comprising:

a keypad;

a transceiver;

a memory, a message stored in the memory; and

a controller programmed to:

a) initiate a call from the wireless device in response to a predetermined key stroke;

b) transmit the stored message through the transceiver to a base when the call is established; and

c) retransmit the stored message through the transceiver when a playback command is received from a base through the transceiver, in response to an operator of the base depressing a keypad key.

24. The wireless device of claim 23, further comprising:

a geolocation receiver for determining position data for the device; and

the controller further programmed to:

d) transmit the position data through the transceiver when the call is established.

25. (Canceled)

26. A wireless device comprising:

a keypad;

a transceiver;

a memory, a message stored in the memory; and

a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke;

b) initiate a timer when the call is established; and

c) transmit the stored message through the transceiver after a predetermined time has elapsed on the timer from when the call was established.

27. A wireless device comprising:

a keypad;

a transceiver;

a memory, a message stored in the memory; and

a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke;

b) storing audio picked up by a microphone after initiating the call;

c) transmit the stored message through the transceiver to a base when the call is established; and

d) reallocate memory to store the audio picked up by the microphone after initiating the call.

28. The wireless device of claim 26 wherein the controller is further programmed to:

d) terminate transmission of the stored message when a voice signal is picked-up by a microphone of the wireless device.

29. The wireless device of claim 26 wherein the controller is further programmed to:

d) terminate transmission of the stored message when a key of the wireless device is activated.

30. A wireless device comprising:

a keypad;

a transducer;

a transceiver;

a memory, the memory storing a message; and

a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke; and

b) combine the stored message with an audio signal from the transducer and transmit the combined signal simultaneously through the transceiver when the call is established.

XI. EVIDENCE APPENDIX

A. Computer generated English translation of Tanaka, (JP Patent Publication No. 08-251313) is attached hereto, as provided through the Japanese Patent Office (7 pages).